

Patent Application  
Docket no.: ACT-2001-UTL3

### Remarks

#### A. Interview

As an initial matter, Applicants thank the Examiner and his supervisor, Examiner Guzo, for participating in a telephonic interview regarding this application on 23 October 2003. Applicants note their receipt of a telecopied version of the Interview Summary on 27 October 2003.

#### B. Status of Claims

Claims 82-115 are pending, claims 1-81 having previously been canceled. Herein, Applicants have amended claims 82, 93, 95, 110, and 112 merely to correct certain typographical errors, many of which were noted in Paper 16. Claim 96 has been canceled without prejudice in order to advance prosecution. As a result claim 96's cancellation, claim 97 has been amended to correct its dependence and to incorporate the subject matter of claim 96, from which it depended. Each of the above amendments is fully supported by the specification and adds no new matter. Moreover, no new search will be required. As these amendments place the claims in condition for allowance (the claims previously having been found to be free of the prior art, and claims 82-95 and 98-115 having been allowed; see Paper 16, page 2, and page 5, respectively), or, alternatively, in better form for appeal, Applicants respectfully submit that their entry at this stage is proper.

Applicants respectfully request reconsideration of the invention in view of the above amendments. It is understood, however, that Applicant reserves the right to pursue subject matter no longer or not yet claimed in this application in this or another application that claims priority hereto.

#### C. Argument.

Certain of the pending claims have been amended to correct the informalities noted in Paper 16 (see pages 2-3, bridging paragraph). Accordingly, the objections raised in Paper 16 in this regard may be withdrawn.

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Claim 96 stands finally rejected under 35 U.S.C. § 112, first paragraph, as allegedly lacking an adequate written description, purportedly because, "The metes and bounds of the term "mutant form" [of Nah-R] are not specifically set forth in the specification" (Paper 16, page 3), and because the mutant Nah-R species listed in the specification (i.e., nahR3 and nahR4) allegedly fail to represent the full genus of Nah-R mutants (Paper 16, page 4). Applicants respectfully traverse, first because this rejection seems to confuse the written description requirement of § 112, first paragraph, with the requirements of § 112, second paragraph, and, more importantly, because it represents a misunderstanding of the law on written description. In particular, the written description requirement does not mandate that an applicant set forth the structure of molecules bounded by a claimed genus. That said, in the case at hand Applicants have set forth both the structure and function of the genus at issue. As to structure, the molecules must be Nah-R mutants. As the nucleotide and amino acid sequences of the Nah-R gene and its products are known in the art (including several mutants, such as nahR3 and nahR4), one skilled in the art would understand that Applicants possessed the invention of now-canceled claim 96. With regard to function, the claim (and that from which it depends) makes clear that the molecule must be a transcriptional regulator (i.e., it must be a mutant Nah-R transcriptional regulator that possesses at least some Nah-R regulatory activity) and that it must also be responsive to one or more benzoate derivatives. For these reasons, Applicants respectfully submit that the invention of claim 96 indeed does comply with the written description requirement of 35 U.S.C. § 112, first paragraph.

That being said, to advance prosecution Applicants have elected to cancel claim 96 without prejudice to its prosecution in a related application, and to amend claim 97 accordingly. As this rejection is thus moot in view of these amendments, Applicants respectfully request that it too be withdrawn.

#### Conclusion

Herein, Applicants have amended certain of the pending claims and canceled the only claim under rejection (i.e., claim 96). As such, Applicants respectfully solicit a notice of allowance. If any issue remains that can be dealt with appropriately without the

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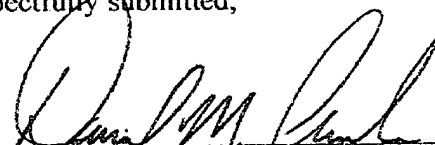
need for a formal action and response thereto, the Examiner is encouraged to telephone the undersigned at his earliest convenience so that the same may be expeditiously resolved.

Respectfully submitted,

Dated: 27 OCT 2003

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